

09/851,849

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REMARKS

1. Claims 1-25 are pending in the application. The amendment previously made to Fig. 6 is objected to. Claims 1-25 are rejected under 35 U.S.C. § 103(a).

2. The amendment to Fig. 6 made in the amendment filed on March 26, 2004, is objected to. The drawing depicts a threaded fastener, numeral 58, protruding through the workpiece 50 on which the claimed router is operating. The objection is that portraying fastener 58 as a threaded fastener adds new matter to the application. The objection states that the fastener "could be some type of rivet drilled through the workpiece." Office Action, p. 2, lines 20-21.

The application as filed contains numerous references to the claimed fasteners as threaded fasteners, while not limiting them to threaded fasteners. Claim 12 as filed, states that the guide is "fastened to the sheet metal by fasteners drilled through the sheet metal." The fasteners may be "3/16" or 5/32" fasteners are used . . . to secure the guide to the skin, using about 35 in-lbs of torque." See specification, p. 11, lines 10-13. A torque wrench is used to control the force used to install threaded fasteners. In contrast, rivets are installed with an axial press force, not with a specified torque. Accordingly, the amendment to Fig. 6 does not add new matter by specifically depicting a threaded fastener. The Examiner is respectfully requested to withdraw the objection to the drawings.

3. Claims 12, 15-17, and 20-21 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 5,533,845 to John Glover ("Glover"). The rejection states that Glover teaches a portable milling machine, the spindle of which is considered a 'router' having a milling bit 61 attached to a frame 12, which is considered the claimed 'platform', in which frame 12 is moved in the generally left/right direction shown in the top portion of Figure 1 along a 'guide' track, located within subframe 30 which is affixed to the workpiece 10 via fasteners drilled into the workpiece. Office Action, p. 3, line 21, to p. 4, line 5.

The rejection states that while Glover teaches fasteners that penetrate into the workpiece, Glover is silent concerning whether fasteners are drilled "through" the workpiece. Office Action, p. 4, lines 14-17. Thus, the Office Action admits that Glover does not describe or suggest the claim limitation of "a guide, fastened to the sheet metal by fasteners drilled through the sheet metal." This claim element requires a guide and fasteners drilled **through** the sheet

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metal (emphasis added). The rejection states that "through" means "extending from one surface to another." Office Action, p. 4, lines 16-17, citing Merriam-Webster's Collegiate Dictionary, 10th ed.

It makes no difference whether Glover's device would work with fasteners drilled through the workpiece, it only matters for obviousness what Glover teaches, discloses or suggests. *In re Novak*, 16 U.S.P.Q. 2043, 2044 (Fed. Cir. 1990) (unpublished opinion, stating that obviousness must be determined in light of what is taught or suggested by the prior art). Even if one were to construe the workpiece of Glover as sheet metal, Figs. 1, 4, and 16 clearly show that Glover's platform 30 is mounted to the workpiece via corresponding attachment sites 33, very thick bosses, such that fasteners through holes 32 and bosses 33 are not drilled through workpiece 10. As the rejection itself admits, Glover does not teach that the fasteners penetrate through the holes and bosses, and thus through a "sheet metal" workpiece from one surface to the opposite surface, as required by Claim 12. Furthermore, citing Glover in this manner is impermissible hindsight, combining the present invention with a reference in order to find the claimed application obvious. *In re Deuel*, 34 U.S.P.Q. 2d 1210 (Fed. Cir. 1995) (reversing rejections for obviousness because of the use of impermissible hindsight).

Glover does not describe or suggest at least this limitation of Claim 12 and dependent Claims 15-17 and 20-21, and is therefore not obvious over Glover. Therefore, the rejection does not make out a prima facie case of obviousness. M.P.E.P. 2143. The Examiner is requested to withdraw the rejection under 35 U.S.C. § 103(a) of Claims 12, 15-17, and 20-21 over Glover.

3. The Office Action rejects Claims 12, 17 and 20 under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 5,106,243 to Christopher Hunt ("Hunt"). The rejection states that Hunt teaches a portable milling machine, the spindle of which is considered a "router." The rejection notes that the spindle unit is affixed to a movable ram or "platform 26" that moves along a dovetail slide 18 of a bed 12, citing Fig. 1 and col. 2, lines 26-65. The rejection states that the device has a vertical adjustment for adjusting the depth of cut of the milling cutter 68, and also that the bed plate 10 of the guiding device is bolted to a workpiece surface, citing col. 4, lines 18-22.

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The rejection admits that Hunt does not describe or suggest fasteners drilled through the sheet metal. Office Action, p. 6, lines 14-15. The rejection also states that Hunt's device will work just as well if fasteners are drilled **through** Hunt's workpiece (emphasis added), and that embodiments of the present invention will work just as well whether the fasteners are drilled **through** the sheet metal (emphasis added), or merely penetrate the "workpiece." Finally, the rejection states that it appears to be a matter of design, the thickness of the "workpiece," as to whether the fasteners are drilled through the sheet metal or merely penetrate.

Applicants traverse the rejections. As discussed above with respect to the rejections under Glover, Hunt also fails to disclose at least the Claim 12 limitation of "a guide, fastened to the sheet metal by fasteners drilled through the sheet metal." It makes no difference whether Hunt's device would work as well with fasteners according to the present invention, because Hunt does not describe or suggest "a guide, fastened to the sheet metal by fasteners drilled through the sheet metal." By the arguments made above, it also does not matter that the present invention might work with fasteners that merely penetrate the sheet metal, rather than fasteners drilled through the sheet metal, depending on workpiece thickness. Applicants have claimed a router apparatus with "a guide, fastened to the sheet metal by fasteners drilled through the sheet metal." Hunt does not describe or suggest at least this limitation of Claim 12 and dependent Claims 17 and 20. Therefore, the rejection does not make out a prima facie case of obviousness against Claims 12, 17 and 20. M.P.E.P. 2143. The Examiner is respectfully requested to withdraw rejections under 35 U.S.C. § 103(a) of Claims 12, 17 and 20 in view of Hunt.

4. The Office Action also rejected Claims 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over either Hunt or Glover as applied to Claim 12. Claims 18, and alternatively, Claim 17, is/are also rejected under the same rationale and references, and further in view of U.S. Pat. No. 3,133,339 to Thomas Ribich ("Ribich"). Claims 13 and 17-19 are patentable because Claim 12 is patentable. Claims depending from allowable claims are themselves allowable.

In addition, Claim 19 does not merely claim a guide made from a plastic material, the material is claimed as being formed "to a uniform height and width." The rejection and the references make no mention of these limitations. Therefore, the rejection of Claims 13 and 17-

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19 under 35 U.S.C. § 103(a) is improper. The Examiner is respectfully requested to withdraw the rejections of Claims 13 and 17-19 over Hunt, Glover and Ribich.

5. Claims 1-5, 7-11, 14, and 22-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,533,845 to John Glover ("Glover"), as discussed for Claims 12-13 and 15-21 above, and further in view of either U.S. Pat. No. 5,503,203 to Ase Stornetta ("Stornetta") or U.S. Pat. No. 3,837,383 to Kenneth Ko ("Ko"). The rejection states that Glover teaches the aspects of the invention discussed above, and also teaches "grips," i.e., the alignment wheels 18 and 19 in Fig. 6, which each have a gripping handle protruding therefrom. Glover does not teach a vacuum fitting for removing machined debris, while Stornetta and Ko both teach such a fitting. Therefore, states the rejection, it would have been obvious to one having ordinary skill in the art to use the attachment of Stornetta and Ko with the device of Glover, to reduce the hazard to the operator. The rejection also repeats the arguments listed above for Glover and Hunt concerning the use of an aircraft skin lap router using a guide with fasteners drilled through the skin as opposed to fasteners that merely penetrate the skin.

Applicants traverse the rejections. As noted above, Glover does not describe or suggest several limitations of the apparatus described in the present application, including at least the Claim 1 limitation of "a guide, fastened to the skin by fasteners drilled through the skin." The Office Action itself notes that Glover, in combination with Stornetta and Ko, does not teach the limitations of fasteners drilled through a workpiece, as applied to independent Claims 1, 22 and 24, and previously noted for independent Claim 12. Office Action, p. 10, lines 17-18.

By the same arguments listed above for the rejections of Claim 12, the arguments in the rejection concerning the desirability of using fasteners that penetrate the skin rather than being drilled through the skin are moot, and may constitute impermissible hindsight. The references must describe or suggest all the limitations of the invention claimed in the present application. Applicants for a patent need not show that the references would have profited from the present invention or do not need the present invention, nor need Applicants demonstrate that the claimed invention would work in a way suggested by the references. Only Glover is cited in this portion of the rejection for the guide and the fasteners, and the Office Action itself admits that Glover

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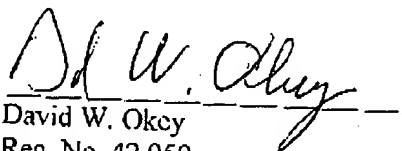
does not describe or suggest a router or fasteners drilled through the skin. Glover also fails to cite other limitations of Claims 1, 22, and 24, and dependent Claims 2-5, 7-11, 14, 23 and 25.

Since Glover, Stornetta, and Ko do not describe or suggest fasteners drilled through the skin of an aircraft to hold a router guide, the rejection has not made out a prima facie case of obviousness. M.P.E.P. 2143. Independent Claims 1, 22 and 24 are therefore allowable, as are their dependent claims. The Examiner is therefore respectfully requested to withdraw the rejection under 35 U.S.C. § 103(a) of Claims 1-5, 7-11, and 22-25. Claim 14 depends from Claim 12, which is allowable by the arguments above, and therefore Claim 14 is also allowable.

6. Claim 6, and alternatively Claim 5, are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,533,845 to John Glover ("Glover"), and further in view of either U.S. Pat. No. 5,503,203 to Ase Stornetta ("Stornetta") or U.S. Pat. No. 3,837,383 to Kenneth Ko ("Ko"), and further in view of U.S. Pat. No. 3,133,339 to Thomas Ribich ("Ribich"). Claims 5 and 6 are allowable because they depend from allowable Claim 1. The Examiner is respectfully requested to withdraw the rejection of Claims 5 and 6.

7. Applicants have argued that the amendment to Fig. 6 in the amendment filed on March 26, 2004, is not new matter in the application, citing support for threaded fasteners for securing the guide to the skin. Applicants request that the Examiner withdraw the objections to the drawing, and withdraw rejections of Claims 1-25 under 35 U.S.C. § 103(a). Applicants submit that the Claims are in form for allowance, and respectfully request the Examiner to advance the claims to allowance. The Examiner is respectfully requested to call the undersigned if such will be of assistance to the Examiner or will help expedite the allowance of the claims.

Respectfully submitted,



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